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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/705,101	11/02/2000	V.M. Segal	30-5076(4015)	4990

7590 06/06/2003

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WESSMAN, ANDREW E

ART UNIT	PAPER NUMBER
1742	16

DATE MAILED: 06/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/705,101	SEGAL ET AL.	
	Examiner	Art Unit	
	Andrew E Wessman	1742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 27 May 2003.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-13 and 67-80 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-13 and 67-80 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>14</u> .	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

1. Claims 1-13 and 67-80 remain for examination. Claims 1, 9, 10, 67, and 68 have been amended.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-4, 7-13, 67-69, 71-74, and 77-80 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Dunlop et al.

Dunlop et al. is applied to the claims for the reasons set forth in paper No. 13, paragraph 5.

With regards to the amended features of claims 1, 9, 10, and 67, the amended features of the claim present different or additional processing steps used to form the claimed product. However, no explanation is given as to how these steps differentiate the claimed product from that of the prior art, and because the patentability of the product by process claim is based on the properties of the product itself (MPEP 2113), the rejection is maintained. Applicant should attempt to clearly set forth the differences between the claimed invention and the prior art by differentiating the products based on differences in their properties, not the means in which the products are produced.

With regards to the amended features of claim 68, the amendment to the claim makes the claim properly dependent from claim 67, but does not alter the scope of the claim.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 5, 6, 75, and 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dunlop et al.

Dunlop et al. is applied to the claims for the reasons set forth in paper No. 13, paragraph 7.

6. Claim 70 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dunlop et al. in view of Segal.

Dunlop et al. in view of Segal is applied to the claims for the reasons set forth in paper No. 13, paragraph 8.

Response to Arguments

7. Applicant's arguments filed May 27, 2003 have been fully considered but they are not persuasive. In the remarks, applicant argues:

(1) Dunlop et al. does not teach the processing steps of the claimed invention; and

(2) Dunlop et al. does not teach targets having precipitates with dimensions of less than 0.5 microns.

With regards to applicant's argument (1), the patentability of the product by process claims of the instant application are based on the properties of the product itself, and not the process used to make the product. See MPEP 2113 regarding product by process claims. Applicant's arguments directed towards differences in the processing of the claimed invention compared to the prior art are of limited relevance to the issues of patentability of the presented claims, and applicant should differentiate the claims from the prior art in terms of the actual properties of the material, and not just the process of making the material. Applicant should mention processing differences only in the context of how such processing differences produce different properties of the material itself, and should strive to point out what property differences arise from such processing differences.

With regards to applicant's argument (2), Dunlop et al.'s material having composition and processing steps similar to that of the claimed invention would be expected to produce a material having similar properties, and the scope of Dunlop et al.'s teaching of "less than 1 micron" encompasses applicant's claimed range of "less than 0.5 microns". Therefore, the material of Dunlop et al. is considered to be substantially the same as that of the claimed invention. Applicant can refute this assertion by showing that the different precipitate size of the claimed invention lends itself to different properties than Dunlop et al., or that Dunlop et al. would have been

incapable of producing the material of the claimed invention having precipitate sizes of less than 0.5 microns.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew E Wessman whose telephone number is (703)305-3163. The examiner can normally be reached on Monday through Friday, 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (703)308-1146. The fax phone numbers for

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the organization where this application or proceeding is assigned are (703)872-9310 for regular communications and (703)872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

RK
ROY KING
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

AEW
June 3, 2003